

SUBMISSION OF THIRD SUPPLEMENTAL REISSUE DECLARATION:

Submitted herewith is a third supplemental reissue declaration (unsigned) for consideration by the Examiner.

ADDITIONAL FEES:

Enclosed herewith is a check in the amount of \$88.00 to cover the additional fee for one (1) extra independent claim in excess of those already paid for. Should it be determined that a further fee is due, authorization is hereby given to charge any such fee to our Deposit Account No. 01-0268.

REMARKS

In the previously filed response to the Office Action dated May 29, 1997, applicant indicated that the supplemental reissue declarations filed July 31, 1996 and January 23, 1997 were in the process of being executed and would be submitted by supplemental response.

In accordance with the present response, the signed original first and second supplemental reissue declarations filed July 31, 1996 and January 23, 1997 are enclosed. In view of the foregoing, applicant respectfully requests that the rejection of claims 5-19 under 35 U.S.C. §251 be withdrawn.

New independent claim 20 has been added to correct an error in claiming less than applicant had a right to claim in the original patent (U.S. Patent No. 5,297,118). The specification has been amended at column 4, line 29 and column 5, line 63 to provide a direct antecedent basis for the terms "marks" and "time indicating device" recited in newly added claim 20. Applicant further presents herewith an unsigned third supplemental reissue declaration specifying the specific errors in the specification and claims which have been corrected by this supplemental response, and how and when the errors arose and were discovered. The original third supplemental reissue declaration is in the process of being executed and will be transmitted to the Examiner shortly by supplemental response.

Paragraph 2 of the third supplemental reissue declaration distinctly specifies the specific error in the claims relied upon. In particular, paragraph 2 states that the original patent is wholly or partly inoperative or invalid by reason of claiming less than applicant had a right to claim in the original patent because none of original patent claims 1-4 or previously added reissue claims 5-19 is directed to an electronic watch provided with a pager for displaying paging messages comprising:

- (a) a receiver for receiving paging messages;
- (b) a time indicating device having a dial, and a plurality of movable hands disposed over the dial for indicating time;
- (c) marks disposed on the dial representative of different paging messages;
- (d) a memory for storing the paging messages received by the receiver;
- (e) a transducer for signalling the receipt of a paging message by the receiver; and
- (f) circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message.

Paragraph 3 of the third supplemental reissue declaration states that new independent claim 20 has been added to correct the error in claiming less than applicant had a right to claim.

Paragraph 4 of the third supplemental reissue declaration specifies how the error in claiming less than applicant had a right to claim in the original patent arose. In particular, paragraph 4 states that the error in claiming less than applicant had a right to claim in the original patent arose through lack of appreciation of all aspects of

the invention at the time the original patent application was filed, and then prosecuted to issue, and, as a result, the subject matter described in paragraph 2 above, and corresponding to claim 20, was not claimed as broadly as applicant had a right to claim.

Paragraph 5 of the third supplemental reissue declaration specifies how and when the error in claiming less than applicant had a right to claim in the original patent was discovered. In particular, paragraph 5 states that the error in claiming less than applicant had a right to claim in the original patent was discovered by applicant's attorney during a review of the original patent in conjunction with the prior art of record subsequent to the filing of the substitute reissue declaration dated July 8, 1996 and the first and second supplemental reissue declarations filed July 31, 1996 and January 23, 1997, respectively. Paragraph 5 further states that the substitute reissue declaration was filed in response to the Examiner's rejection of claims 1-6 in the Office Action dated January 18, 1996 of this reissue application, that the first supplemental reissue declaration was filed to correct the error in claiming less than applicant had a right to claim in the original patent corresponding to the subject matter of claims 7-19, and that the third supplemental reissue declaration was filed to reflect the

amendments made to claims 5 and 6 in response to the Examiner's rejection of claims 5 and 6 under 35 U.S.C. §251.

Paragraph 6 of the third supplemental reissue declaration states that applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification because the specification does not provide a literal antecedent basis for the recitations "time indicating device" and "marks" recited in claim 20.

Paragraph 6 further states that the error in the specification has been corrected by amending the specification at column 4, line 29 to read as --A time indicating device or-- and at column 5, line 63 to read as --marks, such as-- and to insert a comma after "symbols".

Request for Interference with U.S. Patent No. 5,329,501

By this supplemental response, and further to the request in the letter to the Examiner filed with the present application on June 23, 1995 and the request in the supplemental response filed February 27, 1997, applicant requests that an interference now be declared with U.S. Patent No. 5,329,501.

Pursuant to 37 C.F.R. §1.607, applicant provides the following information:

(1) Identification of the Patent

The interfering patent is U.S. Patent No. 5,329,501 which issued July 12, 1994 in the names Pierre-Andre Meister and Andreas Tschanz.

(2) Presentation of a Proposed Count

Applicant proposes the following count in place of the count proposed in the supplemental response filed February 27, 1997:

Proposed Count

An electronic watch with a pager for displaying paging messages comprising: a receiver for receiving paging messages; a time indicating device having a dial, and a plurality of movable hands disposed over the dial for indicating time; marks disposed on the dial representative of different paging messages; a memory for storing the paging messages received by the receiver; a transducer for signalling the receipt of a paging message by the receiver; and a circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message.

(3) **Identification of Claim in the Patent
Corresponding to the Proposed Count**

Applicant identifies independent Claim 1 in U.S. Patent No. 5,329,501 as corresponding to the proposed count.

(4)

(a) **Identification of Claim in the Present
Application Corresponding to the Proposed Count**

Applicant identifies independent claim 20 in the present application as corresponding exactly to the proposed count.

(b) **Explanation of Why Claim 1 of U.S. Patent
No. 5,329,501 Corresponds to the Proposed Count**

Claim 1 of U.S. Patent No. 5,329,501 corresponds to the proposed count and both are drawn to the same patentable invention. The only differences between Claim 1 of Patent No. 5,329,501 and the proposed count are shown by the following underlined language which is present in Claim 1 but either omitted from, or more broadly worded in, the proposed count:

(a) a dial surrounded by a bezel;

(b) a receiver capable of receiving radio broadcast messages for seeking persons;

(c) reception being triggered by the composition on a telephone handset of one of at least two predetermined and distinctive calling numbers;

(d) a control arrangement including at least one stem fitted into a crown adapted to be manually actuated; and

(e) the calling numbers are inscribed on the dial or the bezel in plain language or in coded form.

With respect to the recitations in sub-paragraphs (a) and (d), it is notoriously commonplace in the analog timepiece art to provide a bezel surrounding the dial and to use a control arrangement having a crown and stem to manually adjust the position of the timepiece hands, and inclusion in Claim 1 of a bezel and a control arrangement including a crown and a stem is not a patentable distinction over the proposed count. Stated otherwise, inclusion of a bezel, stem and crown in the proposed count would not amount to a patentable difference.

With respect to the recitation in sub-paragraph (b), it is commonplace in the pager art to provide pager systems with a receiver for receiving radio broadcast paging messages and, therefore, this feature is not a patentable distinction over the proposed count.

With respect to the recitation in sub-paragraph (c), it is commonplace in the pager art to trigger radio broadcast messages (i.e., paging messages) by inputting call numbers via a telephone line. In a conventional pager, for example, when a call number of a person being called or paged is inputted to a telephone, the call signal thereof is given to a radio

paging station through a telephone network and then transmitted therefrom to a high frequency receiving element. Accordingly, the recitation reception being triggered by the composition on a telephone handset of one of at least two predetermined and distinctive calling numbers recited in Claim 1 is not a patentable distinction over the proposed count.

With respect to the recitation in sub-paragraph (e), the use of calling numbers inscribed on the dial in plain language or in coded form constitutes an obvious and trivial variation and, therefore, is not patentably distinct from the "marks disposed on the dial representative of different paging messages" recited in the proposed count. Furthermore, the recitation in Claim 1 of inscribing the calling numbers on either the dial or the bezel cannot be patentably distinct from inscribing them on the dial since Claim 1 recites that the inscriptions may be on either the dial or bezel.

(5) Application of the Terms of Claim 20 of the
Application to the Disclosure of the Application

| <u>CLAIM 20 IN APPLICATION</u> | <u>SUPPORT IN APPLICATION</u> |
|---|--|
| An electronic watch with a pager for displaying paging messages comprising: | Figs. 1-9, specification and claims disclose an electronic watch with a pager; Figs. 6-9 show the electronic watch displaying paging messages |
| a receiver for receiving paging messages; | High frequency receiving circuit 1 in Fig. 1 |
| a time indicating device having a dial, and a plurality of movable hands disposed over the dial for indicating time; | Figs. 6-9 show a time indicating device which indicates time by means of movable hands disposed over the dial |
| a mark representing a paging message disposed on the dial; | Figure 8 shows identifying marks "CUSTOMER", "HOME", etc. disposed on the dial 38 |
| a memory for storing the paging messages received by the receiver; | Received information storing circuit 9 in Figure 1 |
| a transducer for signaling the receipt of a paging message by the receiver; | Alarm element 5; See column 5, line 24 et seq. |
| circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message. | See, for example, column 5, lines 9-44 describing the received information storing circuit; column 4, lines 29-40 describing the analog display unit; and column 5, line 57 et seq. which states "the user can identify the caller by seeing a digital mark on a digit dial 36 pointed by a second hand 37 (pager information indicating hand in this embodiment)" |

(6) **Explanation of How the Requirements of
of 35 U.S.C. §135(b) Are Met**

Claim 20 is for the same or substantially the same subject matter as claim 6, which was present in this reissue application prior to one year from the date on which U.S. Patent No. 5,329,501 was granted, and claim 6 is for the same or substantially the same subject matter as claim 1 of the '501 patent. In view thereof, the requirements of 35 U.S.C. §135(b) have been met.

In view of the foregoing, the application is now believed to be in condition for allowance. Accordingly, applicant respectfully requests that an interference be declared with U.S. Patent No. 5,329,501 and that claims 1-20 of the '501 patent be designated as corresponding to the count.

Respectfully submitted,

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